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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,465	01/09/2004	Yao-Ming Wang	3313-1092P	6419
2292 7590 05/07/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER SCHNEIDER, JOSHUA D	
			ART UNIT 2182	PAPER NUMBER
			NOTIFICATION DATE 05/07/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

## Office Action Summary

Application No.

10/753,465

Applicant(s)

WANG ET AL.

Examiner

Joshua D. Schneider

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10 and 12-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10 and 12-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 4/5/2007 have been fully considered but they are not persuasive. Applicant has argued that the newly amended claim to having the bus control signal being generated is not taught by Higuchi. This may be true, but this limitation is also not taught by the original specification. The only teachings in the specification of the generation of the control signal are found in the last paragraph of page 3 and the last paragraph of page 5. Neither teaches the control signal generated by the host. In fact, on page 5, the specification teaches that the IO controller generates the control signal. As there is no support for this teaching, it will be disregarded with regards to further art rejections.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 2, 4-8, 10, and 12-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4. With regards to claims 1 and 8, there is no teaching original specification of the switch control signal being generated by the host. The only teachings in the specification of the

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generation of the control signal are found in the last paragraph of page 3 and the last paragraph of page 5. Neither teaches the control signal generated by the host. In fact, on page 5, the specification teaches that the IO controller generates the control signal. As the specification teaches away from the newly amended claim limitations, there is no evidence that applicant possessed the invention as claimed.

5. Claims 2, 4-7, 10, and 12-18, are rejected for incorporating the same rejectable subject matter as the independent claim upon which they depend.

6. All further rejections and objections are made in view of the specification as best understood in light of the previous objections and rejections.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 2, 4-8, 10, and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2004/0070952 to Higuchi et al.

9. With regards to claims 1 and 8, Higuchi teaches providing the IO card (Figs. 8-18, element 60) with a socket therein (paragraph 12, Figs. 8-18, especially element SP); inserting the memory card entirely into the socket of the IO card (paragraph 12, Figs. 8-18, element 1 into element 60 by way of SP, see arrows and simulated motion in drawings); connecting the IO card

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to the host system (paragraph 140); and generating a bus control signal through an IO controller on the IO card to switch to a first data bus or a second data bus located in the IO card thereby to change data transmitting path between the memory card and the host system (mode selection in steps 1-4, paragraphs 139-165, Figs. 30).

10. With regards to claims 2, Higuchi teaches directly connecting the first data bus and the second data bus to the host system (IO card connection to host, paragraphs 135-140), and controlling a switch based on the bus control signal to selectively directly connect the inserted memory card to one of the first and second data bus (mode selection in steps 1-4, paragraphs 135-165, Figs. 29-36).

11. With regards to claims 4 and 10, Higuchi teaches the memory card and the IO card further transmit data directly via the first bus without passing through the data bus of the host system (data must pass through IO card to get to host, paragraphs 135-165, Figs. 29-36).

12. With regards to claims 5 and 12, Higuchi teaches the memory card uses a portion of the data buses of the IO card to transmit data with the host system when the memory card is connected to the second data bus to transmit data, the IO card uses remaining data buses to transmit data with the host system (mode selection in steps 1-4, selects portion for use as explained for each of the selectable modes, paragraphs 135-165, Figs. 29-36).

13. With regards to claims 6 and 13, Higuchi teaches the IO card has a socket to electrically and mechanically couple with the memory card (Figs. 8-18, especially see arrows and simulated motion in drawings and electrical interfaces).

14. With regards to claims 7 and 14, Higuchi teaches the host system has an insertion slot to electrically and mechanically couple with the IO card (paragraphs 135-140).

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15. With regards to claims 15 and 17, Higuchi teaches when the second data bus is switched, the memory card employs a portion of the data buses of the IO card to transmit data to the host system (IO card connection with use of selected portion, paragraphs 135-140).

16. With regards to claims 16 and 18, Higuchi teaches when the first data bus is switched, the IO card and the memory card share all data buses of the IO card to interactively transmit data to the host (all are *shared* between the memory and the IO card, limitation is broad enough to encompass simple connection between elements, paragraphs 135-140).

### *Conclusion*


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Schneider whose telephone number is (571) 272-4158. The examiner can normally be reached on M, T, Th, and F, 9-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on (571) 272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JDS



**KIM HUYNH**  
**SUPERVISORY PATENT EXAMINER**  
4/30/02